SUPREME COURT, U.S.

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IN THE

Supreme Court of the United States

October Term, 1962

No. 558

AERONAUTICAL COMMUNICATIONS EQUIPMENT, INC.,
Petitioner,

v.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
Respondent.

PETITION FOR REHEARING

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PETITION FOR REHEARING

Your Petitioner, Aeronautical Communications Equipment, Inc., prays that this Court grant rehearing of its order of January 7, 1963, denying the petition for writ of certiorari, 31 U. S. L. Week 3219 (not yet officially reported), and that a writ of certiorari issue to review the judgment of the Court of Appeals for the Fifth Circuit in the above-entitled cause as prayed for in the petition filed October 24, 1962.

Reasons, Involving the Public Interest, for Granting Rehearing and Issuing the Writ

The conflicting decisions in the Courts of Appeals for the First and Third Circuits, on the one hand, and in the Court of Appeals for the Fifth Circuit, on the other, permit the public to use the invention claimed in an expired patent in the First and Third Circuits and deny the public this right in the Fifth Circuit.

Consider the results in a typical situation inherent in Question 1 of the Petition: a manufacturer in the Seventh Circuit sells a device, which is precisely that of an expired patent, to customers in the First, Third and Fifth Circuits. Under the conditions of the present case and by reason of the conflicting decisions in the several *Pierce* cases (identified on pages 2-3 of the petition for certiorari), the customers in the First and Third Circuits have the right to use and sell the device since the patent covering it has expired and the invention passed into the public domain. However, in the Fifth Circuit, under the identical conditions, the customer will not be free to use or sell the device of the expired patent.

Further, the manufacturer in the Seventh Circuit is in a quandary because he cannot possibly predict the outcome of a suit brought against him for infringement in the Seventh Circuit. The Court of Appeals for the Seventh Circuit might follow the First and Third Circuits and rule that the manufacturer is free to make the device of the expired patent and sell it anywhere in the United States. However, the Court of Appeals for the Seventh Circuit might follow the extraordinary precedent established herein by the Court of Appeals for the Fifth Circuit, and

deprive the Seventh Circuit manufacturer and the consumer public of the right to use the invention of the expired patent, although that would be directly contrary to the Court's proscription in *Scott Paper Co. v. Marcalus Co.*, 326 U. S. 249 (1945), wherein it was held by Mr. Chief Justice Stone at p. 256:

> "Hence any attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal device employed, runs counter to the policy and purpose of the patent laws. . . ."

The public interest urges this Court to remedy the confused state of the law existing in the several judicial circuits by reason of the conflicting *Pierce* decisions. As matters now stand, all of the public in the Fifth Circuit, and possibly other Circuits, are the victims of economic discrimination in being deprived of their right to use the devices of statutorily expired patents that are freely available to their fellow citizens in the First and Third Circuits.

The Court should make it clear beyond doubt that the rule of *Scott v. Marcalus*, *supra*, applies, and that patentees who seek to prolong their monopoly beyond the lawful 17 year statutory period* by obtaining multiple patents seriatim from the Patent Office cannot prevail against the public right to use the invention of an expired patent.

Wherefore, for the reasons involving the public interest set forth above and in the petition for certiorari, it is respectfully urged that rehearing be granted and that, upon such rehearing, a writ of certiorari issue to the Court of Appeals for the Fifth Circuit.

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* 35 USC 154

Respectfully submitted,

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I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the rules of this Court.

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